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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/280,609	03/29/1999	DAVID BARCK	6402	6090

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INTELLECTUAL PROPERTY DEPARTMENT  
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MINNEAPOLIS, MN 55402-1498

EXAMINER

WILLETT, STEPHAN F

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 07/29/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/280,609

Applicant(s)  
Barck et al.

Examiner  
Stephan Willett

Art Unit  
2152



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 22, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri with Patent Number 6,064,982 in view of Christeson et al. with Patent Number 5,926,817.

4. Regarding claim(s) 1-11, 13, 21-25, 27-33 and 39-40, Puri teaches a product configuration system over a LAN. Puri teaches *(a) interactively eliciting from a user on the at least one client a desired subset of possible products having technical configurations* as “the smart configurator provides interactive, off-line product selection dialog in which a matrix of company products is presented”, col. 3, lines 54-56. Puri teaches *(b) in response to the user's desired subset of possible products having technical configurations, downloading from the at*

*least one server to the at least one client limited configuration information and limited configuration programs* as “various packaged options are available for selection and/or individual components may be selected”, col. 5, lines 52-53, a limited configuration engine or interfaces or browser pages that merge user entered information, col. 2, lines 30-39, col. 3, lines 24-46 and col. 5, lines 1-15. Puri teaches © *interactively eliciting from the user on the at least one client a desired technical configuration and preliminarily checking at the at least one client the viability of the desired technical configuration using the limited configuration information and the limited configuration programs* as “the smart configurator determines the appropriate hardware requirements to run the software in an acceptable fashion”, col. 3, lines 63-65. Puri teaches (d) *uploading the desired technical configuration from the at least one client to the at least one server and performing a full check on the viability of the desired technical configuration using full configuration information and full configuration programs on the at least one server* as “the actual hardware requirements for particular software solution are automatically determined by the smart configurator”, col. 5, lines 63-65, “the smart configurator may be optionally placed on-line to check for the existence of more current pricing and SKU information at a company server, etc.”, col. 4, line 16-21, 28-33 and col. 6, lines 46-52. Puri teaches (e) *responsive to the full check, preparing and outputting on the at least one client an electronic order report* as “the smart configurator provides a proposal template that merges various customer related information into a generic proposal”, col. 6, lines 20-22. Puri teaches the invention in the above claim(s) except for explicitly teaching *desired technical configurations*. In that Puri operates to generate configuration fields, the artisan would have looked to the network configuration arts for details of implementing a user selections. In that art, Christeson, a related network configuration system,

teaches an “the same applies to changes to access types and service types”, col. 4, lines 9-11 in order to provide versatility. Christeson specifically teaches that “once the representative has completed entering all required fields and has selected the appropriate optional fields” at col. 6, lines 36-37. A user’s selection of desired fields is possible and only viable alternatives are pursued. Further, Christeson suggests that “error messages are displayed with solutions”, col. 4, lines 29 will result from implementing his system. The motivation to incorporate optional fields insures that only viable configurations are accepted. Thus, it would have been obvious to one of ordinary skill in the art to incorporate options viability as taught in Christeson into the configuration system described in Puri because Puri operates with selectable fields and Christeson suggests that optimization can be obtained with optional fields. Therefore, by the above rational, the above claims are rejected.

5. Regarding claims 12, 34 and 36, Christeson teaches *using a TCP/IP connection to pass an HTTP request from the client to the server* as “such TCP/IP”, col. 12, lines 14. Thus, the above claim limitations are obvious in view of the combination.

6. Regarding claims 14, 15, 16, 20, 26 and 35-38, Puri teaches *the limited configuration programs comprise an HTML page and client-side programs, the client-side programs comprise a plug-in or helper-application and the client-side programs include one or more programs selected from Java, JavaScript, ActiveX, and Helper-Viewer and CGIs* as “dynamic HTML and JAVA script”, col. 3, lines 13. Thus, the above claim limitations are obvious in view of the combination.

7. Regarding claims 17, 18, 19 and, Christeson teaches *the client-side programs are cached on the client, the client-side programs are cached in client-side memory and the client-side*

*programs are cached in client-side disk storage* as "removable storage unit, also called a program storage device or a computer program product, represents a floppy disk, magnetic tape, compact disk, etc.", col. 14, lines 19-22. Thus, the above claim limitations are obvious in view of the combination.

***Response to Amendment***

8. The broad claim language, i.e. limited configuration engine, used is interpreted on its face and based on this interpretation the claims have been rejected.

9. The limited structure claimed, without more functional language, reads on the references provided. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

10. Applicant suggests "Puri teaches a system whereby all of the information and all the functionality is resident on the client side", Paper No. 7, Page 2, lines 19-20. This is correct but Puri's off-line capability is not mutually exclusive based on the teachings of Puri and what was reasonable based on the subject matter as a whole as would have been understood at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Specifically, Puri teaches "the smart configurator may be optionally placed on-line to check for the existence of more current pricing and SKU information at a company server, etc.", col. 4, line 16-21, 28-33 and col. 6, lines 46-52, thus distributed data and applications are taught. In addition, Christeson clearly teaches obtaining configuration data on-line from various servers, col. 11, lines 32-44 as was well known. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

11. Applicant suggests "it is also undesirable in certain situations to pass the entire application

to the client to allow the client to perform the entirety of the application on the client side”, Paper No. 7, Page 1, lines 10-12, and/or contexts, and “repeated exchanges between the client and server are avoided”, page 2, line 10. The above argument is not commensurate with what is presently claimed and therefore will not be considered at this time. Puri teaches a limited configuration engine or interfaces or browser pages that merge user entered information, col. 2, lines 30-39, col. 3, lines 24-46 and col. 5, lines 1-15. Thus, Applicant’s arguments can not be held as persuasive regarding patentability.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (703) 308-5230. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-6606.

16. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9605.

sfw

July 16, 2002



MARK H. RINEHART  
SUPERVISORY PATENT EXAMINER  
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